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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,741

Applicant(s)

BLEUMER, GERRIT

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/20/01;8/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119 is acknowledged.
3. The drawings are objected to because
 - A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of:
 - (1) claim 7 and the "dividing said postage fee units respectively represented by said electronic coins into a plurality of sub-units, and franking different postal items with the respective sub-units";
 - (2) claim 10 and the "additionally including postal matter data in said date stamp characterizing a physical property of a mail piece on which said date stamp is stamped";
 - (3) claim 11 and the identifying "a type of packaging material of said mail piece" in the postal matter; and
 - (4) claim 12 and the identifying "a surface structure of packaging material of said mail piece" in the postal matter;must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).
 - B) the following errors have been noted in the drawings:
 - (1) fig. 3 does not appear to depict what is described in regard to this figure in the paragraph located at page 17, lines 4-20, "Figure 3 shows a part of the protocol sequencing ... protocol is successfully executed (acc = true), then a new postage fee account with number I is opened in the name of the user S.",

since a one to one correspondence between the steps designate as 41, 42, 43 & 44 as depicted in fig. 3 and the associated description of these features can not be found.

(2) fig. 4 does not appear to depict what is described in regard to this figure in the paragraph located between page 17, line 21, and page 19, line 2, "Figure 3 shows a protocol ... for the digital coin that was received.", since a one to one correspondence between the steps designate as 51, 52, 53, 54, 55 & 56 as depicted in fig. 4 and the associated description of these features can not be found.

(3) fig. 5 does not appear to depict what is described in regard to this figure in the paragraph located at page 19, lines 3-8, "When the user S wishes to frank a postal item, the ... A or B. Figure 5 shows the calculations that the user S carries out (block 61).", since a one to one correspondence between the step designate as 61 as depicted in fig. 5 and the associated description of this feature can not be found.

(4) fig. 6 does not appear to depict what is described in regard to this figure in the paragraph located at page 19, lines 9-20, "When a postal item franked in this way proceeds to the inspection unit 13, ... of the fraudulent user.", since a one to one correspondence between the steps designate as 71 as depicted in fig. 6 and the associated description of this feature can not be found.

(5) fig. 6 does not appear to depict what is described in regard to this figure in the paragraph located at page 19, lines 9-20, "When a postal item franked in this way proceeds to the inspection unit 13, ... mod p of the fraudulent user.", since the equations used in box 71 refer to "mod q" and not "mod p" as disclosed.

3.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities:

A) the following errors have been noted in the specification:

(1) applicant's use of an illegible characters/symbols in the phrase "... to 'a' is referenced . H references ...", at lines 4-5, and the symbol above the arrow in line 14 of the paragraph between page 15, line 12, and page 16, line 6, "Protocol actions are written in the standard mathematical notation ... only proceeds when an only if P is valid. participants output a corresponding error message.", is confusing.

(2) the disclosure lacks "Table 1" as disclosed at line 2 of the paragraph located at page 20, lines 18-24, "Figure 7 shows a test imprint of a data stamp with a data matrix of 40 x 40 elements, i.e. the smallest data set of the options cited in Table 1. The ... shown to the left next to the printed data matrix 100."

B) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See for example:

(1) the paragraph located at page 14, lines 9-22, "Large cyclical subgroups of ... from, for example, the National Institute of Standards and Technology (NIST) (NIST99) (<http://csrc.nist.gov/enclption>). The current ... are replaced by scalar multiples of points of a curve.";

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where applicant should delete the http:// from these web sites.

C) the subject matter of:

(1) claim 7 and the “dividing said postage fee units respectively represented by said electronic coins into a plurality of sub-units, and franking different postal items with the respective sub-units”;

(2) claim 10 and the “additionally including postal matter data in said date stamp characterizing a physical property of a mail piece on which said date stamp is stamped”;

(3) claim 11 and the identifying “a type of packaging material of said mail piece” in the postal matter; and

(4) claim 12 and the identifying “a surface structure of packaging material of said mail piece” in the postal matter;

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 1-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claims 1-18, although on of ordinary skill at the time of the invention would known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

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A) in regard to line 5 of claim 1, and how the function of “individualizing said electronic coins for respective mail pieces”, is accomplished, since:

(1) the information required to identify the mail piece is not present in the claim;

(2) the claim lacks an association of the correct amount of the electronic coin for the mail piece; and

(3) the manner in which the electronic coin is to be individualized and hence one of ordinary skill could not determine how to individualize the electronic coin as envisioned by applicant as the invention.

B) in regard to lines 6-7 of claim 1, and how the function of “applying a machine-readable date stamp on a mail piece including an individualized electronic coin for that mail piece”, is accomplished, since:

(1) the information required to identify the mail piece is not present in the claim; and

(2) the claim lacks an association of the correct amount of the electronic coin for the mail piece.

C) in regard to lines 8-9 of claim 1, and how the function of “inspecting the mail piece with said date stamp thereon and determining whether said electronic coin has been multiply used”, is accomplished, since the information required to identify a duplicated electronic coin is missing from this claim, that is a determination that a particular electronic coin has been previously detected so that a duplication may be determined.

D) in regard to claim 3, why and what part of claim 1 comprises “associating an expiration date with each electronic coin”, since the expiration date is not used by the processes recited in lines 5-9 of claim 1.

E) in regard to claim 5, what part of claim 1 comprises “encoding each postage fee unit in a postal item-specific manner for a postal item on which the postage fee unit is used” and how the “encoding in the inspection of the date stamp containing the electronic coin to determine whether the electronic coin has been previously used”,

since the information required to identify a duplicated electronic coin is missing from this claim, that is a determination that a particular electronic coin has been previously detected so that a duplication may be determined.

F) in regard to claims 6-14 what part of claim 1 comprises:

(1) "combining a plurality of said electronic coins for franking said postal item", of claim 6;

(2) "dividing said postage fee units respectively represented by said electronic coins into a plurality of sub-units, and franking different postal items with the respective sub-units", of claim 7;

(3) "generating said postage fee units at a postage fee apparatus authorized by a postal service, using a secret key available only in said postage fee apparatus", of claim 8;

(4) "additionally including at least one of a production date of said date stamp, a production time of said date stamp, a franked postage fee, and an address fee in non-manipulable form in said date stamp", of claim 9;

(5) "additionally including postal matter data in said date stamp characterizing a physical property of a mail piece on which said date stamp is stamped", of claim 10.

(6) identifying "a type of packaging material of said mail piece", in the postal matter of claim 11;

(7) identifying "a surface structure of packaging material of said mail piece", in the postal matter of claim 12;

(8) "adhering a label to said mail piece, said label containing label data forming said postal matter data", of claim 13; and

(9) "generating said postage fee units all of equal value with a postage fee generating apparatus", of claim 14.

G) in regard to lines 13-14 of claim 15, and how the "inspection unit" would determine a duplicate from the "said data", since the information required to identify a duplicated electronic coin is missing from this claim, that is a determination that a

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particular electronic coin has been previously detected so that a duplication may be determined.

6.2 The subject matter of:

A) claim 7 and the “dividing said postage fee units respectively represented by said electronic coins into a plurality of sub-units, and franking different postal items with the respective sub-units”;

B) claim 10 and the “additionally including postal matter data in said date stamp characterizing a physical property of a mail piece on which said date stamp is stamped”;

C) claim 11 and the identifying “a type of packaging material of said mail piece” in the postal matter; and

D) claim 12 and the identifying “a surface structure of packaging material of said mail piece” in the postal matter;

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

6.3 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7.1 Claims 1-18 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing

the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.";

and "Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.", {emphasis added}.

7.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are

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required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the "specified adjusted location" in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

7.1.3 As can be seen from claims 1-18, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1-18 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

7.2 Claims 1-18 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 1-18, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

B) in regard to claims 1-10 & 13-21, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.1 Claims 1, 5-7, 9, 10, 13, 14, 20 & 21, are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Berson (5,513,563) or Peyret (5,688,056) or McCooley.

8.2 Claims 1, 5-7, 9, 10, 13, 14, 20 & 21, are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Whitehouse et al (6,005,945).

8.3 Claims 1, 5-7, 9, 10, 13, 14, 20 & 21, are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Heiden et al (2002/0091545 or 6,438,530).

8.4 In regard to claims 1, 5-7, 9, 10, 13, 14, 20 & 21, either Berson ('563) or Peyret ('056) or McCooley or Whitehouse et al ('945) or Heiden et al ('545 or '530) disclose a postage metering system in which previously obtained electronically money, that is electronic coins are stored in an accounting unit or fee module, are debited to pay for postage as the system dispenses, that is consumes, postage. In these systems a machine readable individualized postage indicia containing encoded information including at least:

A) the time and date the indicia was generated;

B) the postage amount; and

C) an unique number associated with the item of mail that is used to verify the indicia;

is generated for each item of mail. After the generated indicia has been applied to the item of mail by a conventional printer under the control of the postage metering system and the item of mail has been placed into the delivery system, the indicia is inspected to determine if the mailer is attempting fraud on the postal authority by mailing an item mail with an authorized duplicate indicia.

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8.4.1 In regard to claim 13, it is noted that the postage indicia generated by the systems of either Berson ('563) or Peyret ('056) or McCooey or Whitehouse et al ('945) or Heiden et al ('545 or '530) may be applied to either the item of mail or a label which is then applied to the item of mail as is common with in the postage applying arts.

8.4.2 In regard to claim 14, it is noted that the amount of the electronic coins in the systems of either Berson ('563) or Peyret ('056) or McCooey or Whitehouse et al ('945) or Heiden et al ('545 or '530) is dependent of the amount of required postage and hence the amount of the electronic coins may be either of equal value or of different values, note the various values of common stamps with in the postage applying arts.

8.5 Claims 2, 8 & 15-19 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Whitehouse et al (6,005,945).

8.5.1 In regard to claim 2, Whitehouse et al ('945) uses a data base of previous generated indicia to detect duplicate indicia.

8.5.2 In regard to claims 8, 15-19, Whitehouse et al ('945) uses a encryption keys and an encryption unit when adding postage value from a central location, that is postage fee apparatus, to the postage metering system.

8.6 Claims 3 & 4 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Heiden et al (2002/0091545 or 6,438,530).

8.5.1 In regard to claims 3 & 4, either Heiden et al ('545 or '530) uses an expiration date in the process of detecting duplicate indicia.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) in regard to claim 11, the prior art does not teach or suggest the inclusion of information identifying the packaging material with in the postage matter contained with in the postage indicia.

B) in regard to claim 12, the prior art does not teach or suggest the inclusion of information identifying the surface structure of the packaging material with in the postage matter contained with in the postage indicia.

10. The examiner has cited prior art of interest, for example:

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A) Herbert (EP 0856816) disclose the use of an ink which can not be copied to detect duplicate postage indicia.

B) Kara et al (6,249,777) disclose the use of an unique number contained with in an indicia to detect copies and prevent fraud.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/28/04


Edward R. Cosimano
Primary Examiner A.U. 3629